

REMARKS

Claim Rejections – 35 U.S.C. §103

Claims 1, 3, 4-8, 10-12, 14, 16-20, 23, 26, and 27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Safety-Grip* in view of Mencarelli et al. (US 5,348,360).

For a §103 obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. MPEP 2143.

Amended Claim 1 recites a folding advertising system comprising “a railing having an outer surface ... a body having a first side and a second side opposite said first side, said first side having printed indicia forming a visual image, wherein said visual image comprises advertising ... and a releasable adhesive disposed on said second side of said body, said releasable adhesive adhered to the outer surface of said railing.”

Safety-Grip fails to disclose a body having printed indicia forming a visual image, wherein the visual image comprises advertising, as recited in Claim 1. *The American Heritage Dictionary of the English Language, Fourth Edition* provides the following definition:

- advertising** *n* 1. The activity of attracting public attention to a product or business, as by paid announcements in the print, broadcast, or electronic media.

Even if Examiner is arguing that the white (or light) portion of the grip displayed on Page 1 of the *Safety-Grip* reference comprises printed indicia forming a visual image, there is no evidence to suggest that it is a paid announcement for attracting attention to a product or business. This reference does not provide a clear view of what exactly this alleged image constitutes. Even if it comprises the name “Safety-Grip” or information about “Safety-Grip”, it would not constitute advertising. As discussed above, advertising involves a paid announcement for attracting public attention to a product or business. Information about a product that is located on that very same product cannot constitute advertising since a company would not pay itself to place this information on its own product. Therefore, the name “Safety-Grip” on the actual Safety-Grip would not be advertising since it clearly would not be a paid announcement.

Additionally, *Safety-Grip* fails to disclose a body having a releasable adhesive that is adhered to the outer surface of a railing, as recited in Claim 1. Examiner even admits on Page 2 of the Office Action dated December 7, 2005 that the body in *Safety-Grip* “is secured to the railing by a zipper connecting its ends, rather than by an adhesive.” However, Examiner argues that Mencarelli teaches that it was known in the art to attach a padded hand-grip to an elongated object by using an adhesive and that it would have been obvious to one having ordinary skill in the art to use an adhesive to attach the padded hand-grip disclosed by *Safety-Grip* to the railing, as taught by Mencarelli, in order to keep the grip from slipping on the railing.

Applicant respectfully submits that there is no suggestion or incentive found in either *Safety-Grip* or Mencarelli that would motivate one skilled in the art to modify the grip in *Safety-Grip* to be adhered to the outer surface of a railing by a releasable adhesive, as recited in Claim 1. Although Examiner argues that the motivation is to keep the grip from slipping on the railing, the grip disclosed in *Safety-Grip* would not be vulnerable to slipping even without the addition of an adhesive. The cited grip is specially designed for the railing of pools and spas. As seen in the picture on Page 1 of the cited *Safety-Grip* web page, railings for pools and spas are not entirely straight, but rather are significantly curved in order to provide support up and out of the pool or spa and down and into the pool or spa. These railings curve substantially more than 90 degrees. As would be appreciated by one ordinarily skilled in the art, these curves, along with the fastening of the zipper, prevent the grip from slipping. Therefore, there would be no advantage to adding the adhesive to the grip of *Safety-Grip*. Such a modification would only add to the cost and complexity of the product without adding any benefit over the unmodified version. Adding the adhesive to the grip would not make the grip less prone to slippage. If Examiner would like to assert that a grip on these types of curved railings is prone to slippage, Applicant respectfully requests that Examiner provide evidence supporting such an assertion or otherwise withdraw the rejection.

Therefore, Applicant respectfully submits that Claim 1 is nonobvious over *Safety-Grip* in view of Mencarelli.

Since Claims 3-8 and 10-11 are dependent from Claim 1, Applicant respectfully submits that they are also patentable as they contain the same limitations as Claim 1.

Applicant respectfully submits that the same arguments made above with respect to the patentability of Claim 1 are applicable to the patentability of Claim 12 as well.

Since Claims 14, 16-20 and 22-23 are dependent from Claim 12, Applicant respectfully submits that they are also patentable as they contain the same limitations as Claim 12.

Since Claim 15 is dependent from Claim 1, Applicant respectfully submits that it is also patentable as it contains the same limitations as Claim 1.

Applicant respectfully submits that the same arguments made above with respect to the patentability of Claim 1 are applicable to the patentability of Claim 26 as well.

Since Claim 27 is dependent from Claim 26, Applicant respectfully submits that it is also patentable as it contains the same limitations as Claim 26.

Therefore, Applicant respectfully submits that Claims 1, 3-8, 10-12, 14-20, 22-23, and 26-27 are currently in condition for allowance. Reconsideration and withdrawal of the rejection is respectfully requested.

Newly Presented Claims 28, 29 and 30

Applicant respectfully submits that newly presented Claims 28, 29 and 30 find support in the application as originally filed. Therefore, Applicant respectfully submits that no new matter has been introduced.

Since Claims 28, 29 and 30 depend from Claims 1, 12 and 26 respectively, Applicant respectfully submits that they are also patentable as they include the same limitations as their respective parent claims.

Therefore, Applicant respectfully submits that Claims 28, 29 and 30 are currently in condition for allowance.

If the Examiner has any questions regarding this application or this response, the Examiner is requested to telephone the undersigned at 775-586-9500.

Respectfully submitted,
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